

REMARKS

Status of the claims: Claims 1-53 are pending in the current application. Claims 46-53 are withdrawn. Claims 18 and 54-57 are canceled. Claims 1, 16 and 32 are currently amended.

The Examiner has requested Applicant to point out the written description associated with the recitation of “a means for supplying web material” in claim 32. In response Applicant would point out the following portions of the Specification: page 13 line 22 to page 14 line 4; page 20 line 17 to page 22 line 11; page 24 lines 10-15; and page 25 lines 7-18.

Claims 1-15 have been rejected under 35 U.S.C. 103(a) over *Gentry* (US 5,131,416) in view of *Crooks et al.* (U.S. Pub. No. 20020185143). Applicant respectfully traverses this rejection.

The embodiments of the invention are predicated on the basis that as the result of the “locking power” provided by the adsorbant material in the web material, which prevents escape or migration of the flavourant in the web material, the release of the flavourant to the consumer can be limited to the selective portion of the rod of smokable material over which the web material extends. This provides a specific placement of the flavourant within the smoking article. None of the art of record teaches, suggest, or motivates one to use Applicant's solution.

The *Gentry* reference teaches only the use of an inner wrapper which extends over the full length of the tobacco rod. The inner wrapper may carry certain flavoring agents, but since the intent of *Gentry* is to provide that the inner wrapper is burned along the entire length of the cigarette as smoked, there is no concern and therefore no recognition

of the problem of escape or migration of the flavor away from a selective portion of the smoking article.

The deficiency of *Gentry* as a reference is not cured by *Crooks et al.* While *Crooks et al.* discloses the use of a paper strip which may be shorter than the length of the tobacco rod, it is used solely for the purpose of reducing ignition propensity. *Crooks et al.* does not teach, suggest, or motivate one to use a portion of web material for the sole purpose of providing a specific placement of flavourant in an adsorbent material in the web material, so as to limit the delivery of the flavourant to a smoker only over a selective portion of the length of the rod of smokeable material. In fact, the only discussion in *Crooks et al.* relating to flavourants (paragraph [0027]) teaches away from the embodiments of Applicant's invention, and points only to the use of casing or top dressing additives incorporated into the filler materials, that is into the tobacco.

The Examiner has dismissed the language in the preamble of Applicant's claims, relating to the delivery of flavourant to a smoker only during the smoking of a selective portion of the smoking article, as not having patentable weight. Applicant, however, would point out the language quoted in M.P.E.P. §2111.02(II), "However, a 'preamble may provide context for claim construction, particularly, where . . . that preamble's statement of intended use forms the basis for distinguishing the prior art in the patent's prosecution history'. *Metabolite Labs Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62. It is submitted that that is precisely what the disputed language does in this application.

However, to make the distinction even more clear, Applicant has now added the disputed language to the body of each relevant claim.

It is respectfully requested that the above-noted rejection of claims 1-15 be withdrawn.

Claims 16-17, 32-41, and 44-45 as well as claims 18-31 and 42-43 have been rejected under 35 U.S.C. 103(a) over *Tabuchi et al* (EP 1421863) in view of *Crooks et al*.

The deficiencies of *Crooks et al*. as a reference have been discussed above. The reference to *Tabuchi et al*. is drawn to the production of a cigarette to which a perfume is applied in order to weaken the odor of sidestream smoke, that is the smoke which is emitted from the cigarette between puffs by the consumer. That is a function wholly different from the function of Applicant's embodiments which is to deliver flavourant to the consumer only upon the smoking of a selective portion of the smoking article.

Since sidestream smoke is emitted by a cigarette during the burning of the full length of the tobacco rod, *Tabuchi* would direct one skilled in the art to apply its method to the full length of the tobacco rod, not to a selective portion in the manner of Applicant. The *Tabuchi* reference referral to covering only a part of the outer circumferential surface can only mean that only part of the circumferential surface is treated, but it is treated along the entire length of the tobacco rod. Accordingly, the teaching of *Crooks et al*. to use a material along only a portion of a tobacco rod for reducing ignition propensity, would clearly not teach, suggest, or motivate a person skilled in the art, to consider its teachings in combination with *Tabuchi*, and therefore does not provide support as a basis for the Examiner's rejection.

Accordingly it is respectfully requested that the rejection over *Tabuchi* in view of *Crooks et al*. be withdrawn.

It is only with a prior knowledge of Applicant's embodiments, that one could attempt to combine the references as done here to reject Applicant's application.

Accordingly it is submitted that this Application is now in condition for allowance and such action is respectfully requested.

The Examiner is requested to contact the undersigned attorney by phone if any further issues require discussion.

Respectfully submitted,

Date: September 27, 2010

/Charles I. Sherman/
Charles I. Sherman, Reg. No. 22,998
MIDDLETON REUTLINGER
Phone: (502) 625-2745
2600 Brown & Williamson Tower
Louisville, Kentucky 40202
csherman@middreut.com